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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,679	02/23/2004	Lev Ring	2725-31800	1897

78091 7590 05/13/2008  
Conley Rose, P.C  
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Houston, TX 77253-3267

EXAMINER
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BRINSON, PATRICK F

ART UNIT	PAPER NUMBER
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3754

MAIL DATE	DELIVERY MODE
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05/13/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/784,679	<b>Applicant(s)</b> RING ET AL.	
	<b>Examiner</b> Patrick F. Brinson	<b>Art Unit</b> 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-152 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 15-148 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-14 and 149-152 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/4/05, 9/27/05, 8/20/04, 4/6/06, 2/26/07</u> .               | 6) <input type="checkbox"/> Other: _____                          |



## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,029,748 to **Forsyth et al.** in view of U.S. 5,427,698 to **Hirokawa et al.**

The **Forsyth et al.** reference discloses a method and apparatus for radially expanding and plastically deforming expandable tubular assembly including one or more tubular members, comprising coating the interior surfaces of the tubular members with a lubricant, positioning the tubular members within a pre-existing structure and radially expanding and plastically deforming the members within the pre-existing structure. The tubular members are disclosed as being underground in a wellbore casing. **Forsyth et al.** discloses the recited structure, but it does not specifically disclose the composition of the lubricant. The patent to **Hirokawa et al.** discloses a coating composition for lubrication including a solvent carrier, in the form of 47 to 50% methyl ethyl ketone, a dry lubricant material in 1 to 25% polytetrafluoroethylene and an adhesive in the form of an alkyl polymer. It would

have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lubricant of **Forsyth et al.** with the lubricant as suggested by **Hirokawa et al.** wherein it is known to provide lubricants including the recited elements in the recited percentage weights for protection of machine surfaces against seizure and abrasion loss. **Forsyth et al.** discloses the tubular members being utilized underground in a wellbore, but does not specifically disclose the tubular members as structural supports, however, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

2. Claims 149-152 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Forsyth et al.** in view of **Hirokawa et al.** and **Nishizaki et al.**

As discussed in the preceding paragraph, **Forsyth et al.** discloses an expandable tubular assembly including the use of lubricant coupled to the interior surfaces of the tubular members. **Forsyth et al.** does specifically disclose the composition of lubricant. **Hirokawa et al.** discloses a lubricant a coating composition for lubrication including a solvent carrier, in the form of 47 to 50% methyl ethyl ketone, a dry lubricant material in 1 to 25% polytetrafluoroethylene and an adhesive in the form of an alkyd polymer. If it is desired to provide a coloring

pigment to the lubricant, **Nishizaki et al.** discloses that it is known to provide titanium dioxide and to provide dispersants such as calcium silicate to disperse pigments insoluble in organic liquids dispersed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute for the lubricant of **Forsyth et al.** a lubricant including a solvent carrier, a dry lubricant material, an adhesive, as taught by **Hirokawa et al.** wherein it is known to provide lubricants including the recited elements in the recited percentage weights for protection of machine surfaces against seizure and abrasion loss, and to provide , a pigment and a dispersant for the pigment as taught by **Nishizaki et al.** in order to provide the lubricant with a color.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Patrick F. Brinson** whose telephone number is (571) 272-4897. The examiner can normally be reached on M-F 7:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Kevin P. Shaver** can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick F. Brinson/  
Primary Examiner, Art Unit 3754

P. F. Brinson  
May 7, 2008